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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/478,131	01/05/2000	Joseph Nardoza	MAT-2C2B	1285

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EXAMINER

NUTTER, NATHAN M

ART UNIT	PAPER NUMBER
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1711

DATE MAILED: 02/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/478,131

Applicant(s)

NARDOZZA ET AL.

Examiner

Nathan M. Nutter

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 December 2005.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9, 11-19 and 21-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9, 11-19 and 21-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☒ Interview Summary (PTO-413)
Paper No(s)/Mail Date. 10-05.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

In view of the Response filed 5 December 2005, the following is placed in effect.

The rejection of claims 1 and 4 under 35 U.S.C. 102(e) as being anticipated by Cramer et al (USPN 6,102,937) is hereby expressly withdrawn.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-9, 11-19 and 21-25 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-23 of U.S. Patent No. 6,503,582. Although the conflicting claims are not identical, they are not patentably distinct from each other because the practice of the claims of the parent patent would necessarily require the composition, as recited. The patent discloses and teaches all parameters necessary to produce the invention now claimed, and as employed in the claims of the patent.

Claim Interpretations

The combination of the several ingredients of the formulation, due to the number of required constituents, necessarily would not be found within the confines of a single reference. Only the superabsorbant polymer, the binder, colorant, metal glitter and preservative are disclosed and recited as having particular functions. No specific function is disclosed for either the gum or gelatin other than that the gum provides a "cohesiveness to the composition," and that the gelatin is "fluid-swellable." Since these constituents provide art-recognized functions to compositions embracing the composites of the instant claims, the various constituents will be viewed in their known capacities.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-9, 11-19 and 21-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cordova (USPN 5,990,205) or Bowles (USPN 5,333,405), taken with Levy (USPN 5,698,210), or Young, Sr. et al (USPN 5,432,000), and in further view of Gebhard et al (USPN 5,612,397) and Hughes et al (USPN 4,859,242).

The combination of references teaches the constituents, as recited and claimed herein, for their art-recognized functions in compositions.

The reference to Cordova (USPN 5,990,205) teaches the conventionality of using a gum, including guar, gelatin, a binder, a colorant, reflective metal particles and a preservative in compositions similar to that recited and claimed. Note column 2 (lines 17-46) for the use of polymer binders, including those composed of pyrrolidone, guar gum and gelatin. The employment of a colorant is shown at column 5 (lines 12 et seq.). The preservative is employed at column (lines 40-47).

The patent to Bowles teaches the conventionality of using a gum and gelatin, as binders for dyes and glitter materials. Note column 7 (lines 16-26) for the binder, gum, gelatin, dye and glitter components. The patent clearly includes other additives, which at column 5 (lines 17-24) include thixotropic agents, fillers, flow control agents, etc. which would suggest the inclusion of other absorbents, including super absorbents.

The reference to Levy (USPN 5,698,210) teaches the manufacture of a composite that may include a super absorbent polymer, a natural gum, gelatin and a binder. Note column 10 (line 51) to column 11 (line 32) which also teaches the inclusion of a dye, as recited in claim 4. The composition may include a preservative at column 8 (lines 44-63).

The patent to Young, Sr. et al (USPN 5,432,000) shows the conventionality of using a binder with a pigment and metallic flakes, as herein claimed. Note column 9 (lines 6 et seq.) for the use of a polymer binder, column 10 (lines 47-64) for the use of colorants and column 12 (lines 4-5 and 40-55) for the inclusion of super absorbent particles and metallic flakes. Further, note column 13 (lines 36-59) for the use of graft copolymer super absorbents.

The reference to Gebhard et al (USPN 5,612,397) teaches the particular binder, that being a copolymer of vinyl pyrrolidone and vinyl acetate, at column 2 (lines 37-59), which are propitious for binding glitter, as taught at column 1. The reference shows the conventional use of preservatives at column 7 (lines 12-20).

The reference to Hughes et al (USPN 4,859,242) employs gums to make a uniform suspension of metallic flakes in a polymer thickener. Note column 1 (lines 53-64), column 2 (lines 27-65), column 3 (lines 23-29) and the claims beginning at column 4.

The several components, thus, have conventional and known uses to those having an ordinary skill in the art as regards the production of biodegradable compositions, as disclosed and recited herein. To include the super absorbents of Levy (USPN 5,698,210) or Young, Sr. et al in the composition of either Cordova or Bowles, for its recognized function would have been prima facie obvious to an artisan of ordinary skill. Further, since these constituents would not be found in any one reference, interpolation of the exact weight percentages for each separate compound need not be shown by any of the several references included in the rejection. The various components are shown by the references to be known in the production of composites and would be used in accordance with the desired characteristics of the final composition as well as cost, availability and other factors of manufacturing and handling. Manipulation of the various components as to inclusion parameters, particle size or distribution, would have been obvious modifications to an artisan in view of these considerations. As such, the instant claims are deemed to be obvious over the

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teachings of the references. No unexpected results have been shown on the record relating to any particular component or inclusion of any components.

Response to Arguments

Applicant's arguments filed 5 December 2005 have been fully considered but they are not persuasive.

With regard to the rejection of claims 1-9, 11-19 and 21-25 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-23 of U.S. Patent No. 6,503,582, since the scope of the claims, as originally filed has changed, the obviousness-type double patenting rejection is being maintained. A timely filed Terminal Disclaimer is necessary to overcome the rejection.

With regard to the rejection of claims 1-9, 11-19 and 21-25 under 35 U.S.C. 103(a) as being unpatentable over Cordova or Bowles, taken with Levy or Young, Sr. et al and in further view of Gebhard et al and Hughes et al, it is pointed out that the instant claims are drawn to a composition and not to any specific use thereof. The specific forms of the constituents, as they are presented into the composition, whether solid, particulate or in a molding plastic form is a matter of solvent. The instant claims do not exclude the addition of a fluid or solvent, such as water. the recitations of "granular" are not deemed relevant to patentability. The recitations do not lend patentability to the claims since the specific form of the ingredients would be a matter of choice to the skilled artisan. This choice may be based on factors, such as availability of materials, product shipping and handling, desired packaging and other preferences or matters to prepare the product for sale, or for the addition of water or other fluid by the consumer,

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as is well known for many marketed products. The form of the product does not lend patentability to the claims in a composition where the constituents of that composition are employed in art-recognized functions, as herein. This is especially true herein since the application of a fluid or water is intended by the user as asserted at page 11, 2nd full paragraph, of the Specification. The instant claims do not exclude such addition, as pointed out above. Further, the encapsulating material disclosed by Bowels is not excluded by the claim recitations herein. The references cited show the conventionality of what applicants have combined and are cited for the reasons set out above. Clearly, the claims are drawn to a composition. The particular method of use of this composition is irrelevant regarding patentability of the claims. The prior art references show the conventionality of the constituents employed in their art-recognized capacities. A binder for metallic flakes would act as a binder for metallic flakes regardless of what other constituents may be added. Likewise, a preservative taught for use in a guar, gelatin or other natural resin would still behave, and would be fully expected to do so, as a preservative. Applicants ignore the fact that the claims are drawn only to a composition, and not a product with use.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within

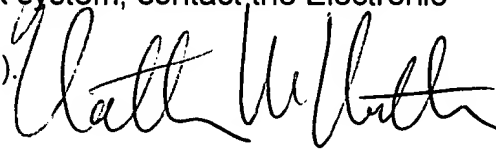
TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nathan M. Nutter whose telephone number is 571-272-1076. The examiner can normally be reached on 9:30 a.m.-6:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James J. Seidleck can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Nathan M. Nutter
Primary Examiner
Art Unit 1711

nmn

19 February 2006